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JGJr: 07-03

Paper No: 15

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OFFICE OF PETITIONS

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In re Application of:
Gonzalo
Filed: 20 September, 1999
Application No. 09/399,415
Docket No.: (None)

ON PETITION

This is a decision on the petition filed herein on 14 July (and supplemented on 25 July), 2003, under 37 C.F.R. §1.137(b)¹ to revive the above-identified application as having been abandoned due to unintentional delay.

The petition under 37 C.F.R. §1.137(b) is **GRANTED**.

NOTE: Petitioner was reminded by telephone on Thursday and Friday 24 and 25 July, 2003, that there is no indication contained in the record that Petitioner herein was ever empowered to prosecute the instant application.

If Petitioner desires to receive future correspondence regarding this application, the appropriate power of attorney documentation must be submitted.

A courtesy copy of this decision will be mailed to Petitioner.

¹ Effective December 1, 1997, the provisions of 37 C.F.R. §1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 C.F.R. §1.137(b). a grantable petition filed under the provisions of 37 C.F.R. §1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 C.F.R. §1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c). (Emphasis supplied.)

However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary.

BACKGROUND

The record indicates that:

- Applicant failed to reply timely and properly to the non-final Office action mailed on 19 February, 2002, with reply due (absent extension of time) on or before Monday, 20 May, 2002;
- the application went abandoned after midnight 20 May, 2002;
- Notice of Abandonment was mailed on 2 October, 2002;
- in the original petition under 37 C.F.R. §1.137(a)--filed on 4 March and dismissed on 17 March, 2003, for failing to satisfy the "showing" requirement under the regulation:

--Petitioner acknowledged that his attorneys received the Office action on 25 February, 2002 (less than a week after it was mailed), but contended that because he did not receive those materials from his attorneys until 19 May, 2002, the period of response should have been reset;

--Petitioner's statement clearly indicated that, after his receipt of the Office action from his Counsel, Petitioner had time to submit a reply within the shortened statutory period, and could have submitted a request and fee for an extension of time under 37 C.F.R. §1.136(a), however, Petitioner failed to do either;

--rather, Petitioner sought, unsuccessfully, to prevail upon the Examiner to restart the period for reply;²

--moreover Petitioner failed to reply to the Office action mailed to his Counsel on 19 February, 2002;

- the instant petition (with fee) provides the statement of unintentional delay and is accompanied by an amendment as a reply--the Terminal Disclaimer submitted is unnecessary and the fee (\$55.00) is being refunded to Petitioner Scott J. Fields via Treasury check;

² Petitioner wrote to the Examiner asking that the reply period be restarted (letter dated 10 June, filed 9 July, 2002. (As noted above, the Examiner did not comply with that request.) In that letter, Petitioner stated that he was sending further materials, which Petitioner apparently failed to do.

- on 25 July, 2003, Petitioner submitted authorization for the necessary additional funds--to wit: the balance of the petition fee and the (request and) fee for a two- (2-) month extension of time. It is noted, however, that Petitioner has a signature/address block with an incorrect zip code (two many digits) in his 25 July, 2003, filing, and that the Revocation/Power of Attorney which Petitioner was to file was not among the 25 July, 2003, filing.

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).³

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.⁴

Delays in responding properly raise the question whether delays are unavoidable.⁵ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁶ And the Petitioner must be diligent in attending to the matter.⁷

(Moreover, it long has been the position of the Office that the use of the filing periods (such as in 37 C.F.R. §1.137(b)) as an "extension of time" is an "abuse" of the procedures for reviving abandoned applications, and is contrary to the meaning and intent of the regulation.⁸ The Office

³ 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

⁴ Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

⁵ See: Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

⁶ See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁷ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

⁸ See: In re Application of S, 8 USPQ2d 1630, 1632 (Comm'r Pats. 1988). Where there is a question whether the delay was unintentional, the petitioner must meet a burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 C.F.R. §1.137(b). See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

has indicated that petitions to revive must be filed promptly after the applicant becomes aware of the abandonment.⁹ Such does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.¹⁰

CONCLUSION

Accordingly, the petition to revive under 37 C.F.R. §1.137(b) hereby is granted.

This application is being forwarded to Publications Branch to be processed into a patent.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.



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cc:

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⁹ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

¹⁰ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.